

Practitioner's Docket No. 0055.00



GP 1615  
PATENT 3/31/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Schutt, Ernest G.

Application No.: 09/218,213

Group No.: 1615

Filed: December 22, 1998

Examiner: R. Bawa

For: STABILIZED PREPARATIONS FOR USE IN NEBULIZERS

FEB 11 2000

Assistant Commissioner for Patents  
Washington, D.C. 20231

TECH CENTER 1800/2800

STATEMENT UNDER 37 C.F.R. section 3.73(b)  
ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION

1. The assignee(s) of the entire right, title and interest hereby seek(s) to take action in the PTO in this matter.

IDENTIFICATION OF ASSIGNEE

2. Name of assignee: Inhale Therapeutic Systems, Inc.  
Type of assignee: Corporation

CERTIFICATION UNDER 37 C.F.R. sections 1.8(a) and 1.10\*  
(When using Express Mail, the Express Mail label number is *mandatory*;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

- ☒ deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

37 C.F.R. section 1.8(a)

37 C.F.R. section 1.10\*

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TRANSMISSION

- ☐ transmitted by facsimile to the Patent and Trademark Office.

Date: 2/1/2000

Kathy Honnert  
Signature

Kathy Honnert  
(type or print name of person certifying)

**\*WARNING:** Each paper or fee filed by "Express Mail" *must* have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. section 1.10(b).  
"Since the filing of correspondence under [section] 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will *not* be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

**PERSON AUTHORIZED TO SIGN**

3. Name of person authorized to sign on behalf of assignee: Stephen L. Hurst  
Title of person authorized to sign: General Counsel

**BASIS OF ASSIGNEE'S INTEREST**

Ownership by the assignee is established as follows:

**A.**

1. An assignment from the inventor(s) of the matter identified above, which was recorded in the PTO at Reel 9836, Frame 0044.

**B.** A chain of title from the inventor(s) to the current assignee as shown below:

1. From: Ernest G. Schutt; Thomas E. Tarara; Luis A. Dellamary; Jeffry G. Weers;  
and Alexev Kabalnov

To: Alliance Pharmaceutical Corp.  
Recorded in PTO: Reel 9836, Frame 0044

2. From: Alliance Pharmaceutical Corp.

To: Inhale Therapeutic Systems Inc  
Recorded in PTO:

**COPIES OF DOCUMENTS IN CHAIN OF TITLE**

Copies of the assignment(s) or other document(s) in the chain of title are attached as follows:

A1 Assignment from inventors to Alliance Pharmaceutical Corp.

B1 Assignment from Alliance Pharmaceutical Corp. To Inhale Therapeutic Systems, Inc.

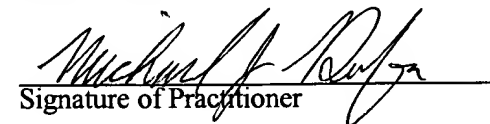
B2

Date: 2/1/00

Reg. No.: 38,740  
Tel. No.: 650-631-3100



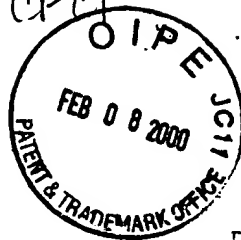
Signature of authorized person  
Stephen L. Hurst  
General Counsel



Signature of Practitioner

Michael J. Rafa  
Inhale Therapeutic Systems, Inc.  
150 Industrial Road  
San Carlos, CA 94070

AMIA.171(CPI)  
NAH



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

JUNE 08, 1999

PTAS

KNOBBE, MARTENS, OLSON & BEAR  
NED ISRAELSEN  
620 NEWPORT CENTER DRIVE  
SIXTEENTH FLOOR  
NEWPORT BEACH, CA 92660



\*100994834A\*

FEB 11 2000

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

TECH CENTER 1633/2300

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 03/22/1999

REEL/FRAME: 9836/0044  
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

SCHUTT, ERNEST G.

DOC DATE: 02/11/1999

ASSIGNOR:

TARARA, THOMAS E.

DOC DATE: 02/11/1999

ASSIGNOR:

DELLAMARY, LUIS A.

DOC DATE: 02/11/1999

ASSIGNOR:

WEERS, JEFFRY G.

DOC DATE: 02/11/1999

ASSIGNOR:

KABALNOV, ALEXEY

DOC DATE: 02/02/1999

ASSIGNEE:

ALLIANCE PHARMACEUTICAL CORP.  
3040 SCIENCE PARK ROAD  
PATENT DEPARTMENT  
SAN DIEGO, CALIFORNIA 92121

*Handwritten signature*

9836/0044 PAGE 2

SERIAL NUMBER: 09218213  
PATENT NUMBER:

FILING DATE: 12/22/1998  
ISSUE DATE:

TONYA LEE, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

03-26-1999



TO THE ASSISTANT COMMISSIONER FOR

100994834

documents or copy thereof.

1. Name of conveying party(ies): (If multiple assignors, list numerically)

1. Ernest G. Schutt
2. Thomas E. Tarara
3. Luis A. Dellamary
4. Jeffry G. Weers
5. Alexey Kabalnov

2. Name and address of receiving party(ies): 51

Name: Alliance Pharmaceutical Corp.  
 Internal Address: Patent Department  
 Street Address: 3040 Science Park Road  
 City: San Diego State: CA ZIP: 92121

Additional name(s) of receiving party(ies) attached?  
 ( ) Yes (X) No

Additional name(s) of conveying party(ies) attached:  
 ( ) Yes (X) No



2. Nature of conveyance:

- (X) Assignment  
 ( ) Merger  
 ( ) Security Agreement  
 ( ) Change of Name  
 ( ) Other:

4. Application number(s) or Patent number(s):

( ) Application(s) filed herewith Execution Date(s):

(X) Patent Application No.: 09/218,213  
 Filing Date: 22 December 1998

( ) Patent No.:  
 Issue Date:

Additional numbers attached? ( ) Yes (X) No

Execution Date: (If multiple assignors, list execution dates in numerical order corresponding to numbers indicated in 1 above)

1. February 11, 1999
2. February 11, 1999
3. February 11, 1999
4. February 11, 1999
5. February 02, 1999

3. Name and address of party to whom correspondence concerning document should be mailed:

Name: Ned Israelsen  
 Knobbe, Martens, Olson & Bear  
 Internal Address: Sixteenth Floor  
 Street Address: 620 Newport Center Drive  
 City: Newport Beach State: CA ZIP: 92660  
 Attorney's Docket No.: ALLIA.171CPC1

7. Total fee (37 CFR 3.41): \$40.00

- (X) Check Enclosed  
 (X) Authorized to be charged to deposit account if an additional fees are required, or to credit an overpayment

8. Deposit account number: 11-1410

6. Total number of applications and patents involved: 1

Please charge this account for any additional fees which may be required, or credit any overpayment to this account.

4. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct, and any attached copy is a true copy of the original document.

Ned A. Israelsen  
 Name of Person Signing

Signature

3-15-99  
 Date

Registration No. 29,655

Total number of pages including cover sheet, attachments and document: 5

Mail documents to be recorded with required cover sheet information to:

03/25/1999 JSHABAZZ 00000263 09218213

01 FC:581

40.00 OP

Assistant Commissioner for Patents  
 Box Assignments  
 Washington, D.C. 20231

40E

MRD 3.22.99

### ASSIGNMENT

WHEREAS, We, Ernest G. Schutt, a citizen of the United States of America, residing at 12139 Ragweed Street, San Diego, California, 92129, Thomas E. Tarara, a citizen of the United States of America, residing at 3120 Felton Street, San Diego, California, 92104, Luis A. Dellamary, a citizen of Mexico, residing at 838 Redberry Court, San Marcos, California, 92069-1846, Alexey Kabalnov, a citizen of Russia, residing at 2900 Highland Drive, Corvallis, Oregon 97330, and Jeffry G. Weers, a citizen of the United States of America, residing at 12191 Salix Way, San Diego, California, 92129, have invented certain new and useful improvements in **Stabilized Preparations For Use In Nebulizers** for which we have filed an application for Letters Patent in the United States, Serial No. 09/218,213, Filed December 22, 1998;

AND WHEREAS, Alliance Pharmaceutical Corp. (hereinafter "ASSIGNEE"), a New York Corporation, with its principal place of business at 3040 Science Park Road, San Diego, California 92121, desires to acquire the entire right, title, and interest in and to the said improvements and the said Application:

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said inventors, do hereby acknowledge that we have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, the entire right, title, and interest throughout the world in, to and under the said improvements, and the said application and all divisions, renewals and continuations thereof, and all Letters Patent of the United States which may be granted thereon and all reissues and extensions thereof, and all rights of priority under International Conventions and applications for Letters Patent which may hereafter be filed for said improvements in any country or countries foreign to the United States, and all Letters Patent which may be granted for said improvements in any country or countries foreign to the United States and all extensions, renewals and reissues thereof; and we hereby authorize and request the Commissioner of Patents of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents on applications as aforesaid, to issue all Letters Patent for said improvements to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY covenant and agree that we will communicate to the said ASSIGNEE, its successors, legal representatives and assigns, any facts known to us respecting said improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper patent protection for said improvements in all countries.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 11 day of Feb, 1999

Ernest G. Schutt  
Ernest G. Schutt

STATE OF California .  
COUNTY OF San Diego : ss.

On 11 Feb 99, before me, Diane L. Trus personally appeared Ernest G. Schutt, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]



Diane L. Trus  
Signature

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 11 day of Feb, 1999.

Thomas E. Tarara  
Thomas E. Tarara

STATE OF California .  
COUNTY OF San Diego . ss.

On 11 Feb 99, before me, Diane L Trus personally appeared Thomas E. Tarara, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]



Diane L Trus  
Signature

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 11 day of Feb, 1999.

Luis A. Dellamary  
Luis A. Dellamary

STATE OF California .  
COUNTY OF San Diego . ss.

On 11 Feb 99, before me, Diane L Trus personally appeared Luis A. Dellamary, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]



Diane L Trus  
Signature

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 11<sup>th</sup> day of Feb, 1999

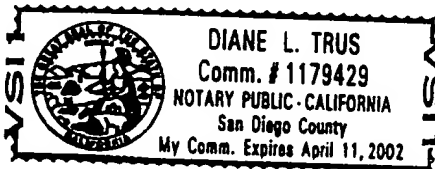
  
Jeffrey G. Weers

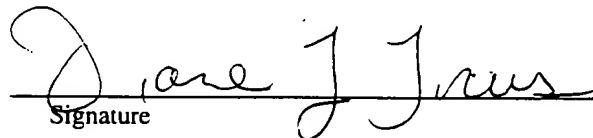
STATE OF California .  
COUNTY OF San Diego . ss.

On 11 Feb 99, before me, Diane L. Trus personally appeared Jeffrey G. Weers, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]



  
Signature



IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 2 day of February 1999

Alexey Kabalnov  
Alexey Kabalnov

STATE OF

Oregon

COUNTY OF

Benton

•

• ss.

•

Else Englen

On Feb 2, 1999, before me, Alexey Kabalnov personally appeared Alexey Kabalnov, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person(s) whose name(s) is/are subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity(ies), and that by his signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

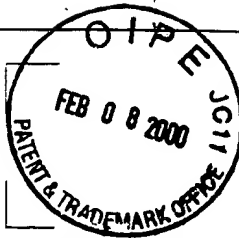
WITNESS my hand and official seal.

[SEAL]

Else Englen  
Signature



FORM PTO-1619A  
Expires 06/30/99  
OMB 0651-0027



U.S. Department of Commerce  
Patent and Trademark Office  
**PATENT**

## RECORDATION FORM COVER SHEET PATENTS ONLY

TO: The Commissioner of Patents and Trademarks: Please record the attached original document(s) or copy(ies).

### Submission Type

- ☒ New
- ☐ Resubmission (Non-Recordation)  
Document ID#
- ☐ Correction of PTO Error  
Reel #  Frame #
- ☐ Corrective Document  
Reel #  Frame #

### Conveyance Type

- ☒ Assignment ☐ Security Agreement
- ☐ License ☐ Change of Name
- ☐ Merger ☐ Other
- U.S. Government**  
(For Use ONLY by U.S. Government Agencies)
- ☐ Departmental File ☐ Secret File

### Conveying Party(ies)

- ☐ Mark if additional names of conveying parties attached
- Name (line 1)  Execution Date  
Month Day Year

Name (line 2)

### Second Party

Name (line 1)

Name (line 2)

### Receiving Party

- ☐ Mark if additional names of receiving parties attached

Name (line 1)

Name (line 2)

Address (line 1)

Address (line 2)

Address (line 3)     
City State/Country Zip Code

☐ If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative is attached. (Designation must be a separate document from Assignment.)

### Domestic Representative Name and Address

Enter for the first Receiving Party only.

Name

Address (line 1)

Address (line 2)

Address (line 3)

Address (line 4)

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Mail documents to be recorded with required cover sheet(s) information to:  
Commissioner of Patents and Trademarks, Box Assignments, Washington, D.C. 20231

**Correspondent Name and Address**

Area Code and Telephone Number (650) 631-3100

Name Michael J. Rafa

Address (line 1) Inhale Therapeutic Systems, Inc.

Address (line 2) 150 Industrial Road

Address (line 3)

Address (line 4) San Carlos, CA 94070

**Pages**

Enter the total number of pages of the attached conveyance document including any attachments.

# 4

**Application Number(s) or Patent Number(s)**

☐ Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

**Patent Application Number(s)**

09/219.736 09/218.209 09/218.213  
09/218.212

**Patent Number(s)**

If this document is being filed together with a new Patent Application, enter the date the patent application was signed by the first named executing inventor.

Month Day Year

**Patent Cooperation Treaty (PCT)**

Enter PCT application number  
only if a U.S. Application Number  
has not been assigned.

PCT US99/06855

PCT

PCT

PCT

PCT

PCT

**Number of Properties**

Enter the total number of properties involved.

# 5

**Fee Amount**

Fee Amount for Properties Listed (37 CFR 3.41): \$ 200.00

Method of Payment:  
Deposit Account

Enclosed ☐

Deposit Account ☒

(Enter for payment by deposit account or if additional fees can be charged to the account.)

Deposit Account Number:

# 500348

Authorization to charge additional fees:

Yes ☒

No ☐

**Statement and Signature**

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. Charges to deposit account are authorized, as indicated herein.

Michael J. Rafa

Name of Person Signing

Michael J. Rafa

Signature

11/19/00

Date

## **ASSIGNMENT OF PATENT RIGHTS**

Alliance Pharmaceutical Corp., a corporation organized and existing under the laws of New York, having a place of business at 3040 Science Park Road, San Diego, California 92121 (hereinafter called "Assignor"), hereby assigns certain patent rights to Inhale Therapeutic Systems, Inc., a corporation organized and existing under the laws of Delaware having a place of business at 150 Industrial Way, San Carlos, California 94070 (hereinafter called the "Assignee"):

WHEREAS Assignor is the owner of the following patent applications set forth on Exhibit A; and

WHEREAS Assignor has agreed with Assignee for the transfer to it of the whole right, title and interest in and to said applications, and inventions therein pursuant to an Asset Purchase Agreement between Assignor and Assignee dated October 4, 1999 (the "APA");

NOW THIS ASSIGNMENT WITNESSETH that in pursuance of the said agreement and in consideration of the sum of amounts paid to Assignor pursuant to the APA (the receipt of which Assignor hereby acknowledges), Assignor, as beneficial owner, hereby assigns and transfers to Assignee said inventions, said applications, and any and all Letters Patent or Patents in the United States of America and all foreign countries which may be granted therefor and thereon, and in and to any and all divisions, continuations, and continuations-in-part of said applications, or reissues or extensions of said Letters Patent, and all rights, privileges and advantages appertaining thereto, including any and all rights to damages, profits or recoveries of any nature for past infringement of said Letters Patent, and the payment of any and all maintenance fees, taxes, and the like, TO HOLD the same unto and to the use of Assignee, its successors and assigns absolutely during the residue of the respective terms for which the said Letters Patent were granted and during any such terms, and for any and all rights extending from said applications and reissues.

Executed at San Diego as of the 3<sup>rd</sup> day of November 1999

Assignor: Alliance Pharmaceutical Corp.

Signature: \_\_\_\_\_



Lloyd A. Rowland

Vice President and General Counsel